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OFFICE OF PETITIONS

In re Application of
Kadima, et al.
Application No. 10/657,737
Filed: 3 September, 2003
Attorney Docket No. 11701/46003

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ON PETITION

This is a decision on the papers submitted and considered as a petition filed on 21 May, 2004, and refiled in somewhat different form on 26 August, 2005, under 37 C.F.R. §1.47.

For the reasons set forth below, the petition under 37 C.F.R. §1.47 is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates:

- the instant application was filed on 3 September, 2003, without, *inter alia*, a fully executed oath/declaration;

- on 26 November, 2003, the Office mailed a Notice of Missing Parts indicating, *inter alia*, that a fully executed oath/declaration was required within two months;
- on 21 May, 2004, Petitioner Siu K. Lo(Reg. No. 46,877) filed, *inter alia*, the instant petition, along with a discussion of the history of the application, an averment that co-inventors Tenshuk A. Kadima (Mr. Kadima) and Robert C. Tuttle (Mr. Tuttle) cannot be found, co-inventor Howard A. Kaplan (Mr. Kaplan) is deceased and his legal representative Carole Grad (Ms. Grad) does not wish to sign the declaration because she does not understand it and does not wish to be subject to penalties for making a false declaration, and Petitioner also avers that four additional inventors need to be added (to wit: Lajos Hegedus (Mr. Hegedus), Krisztina Krempels (Ms. Krempels), Krisztina Paal (Ms. Paal) and Gabor Petho (Mr. Petho)), however the wholly unsigned oath/declaration lists these persons while Petitioner has neither obtained their signature on the oath/declaration nor made a showing comporting with 37 C.F.R. §1.47;
- the Office mailed a second Notice of Missing Parts on 8 June, 2004, indicating that Petitioner failed to address the absence of the signatures of alleged non-signing inventors Mr. Hegedus, Ms. Krempels, Ms. Paal and Mr. Petho, and the Notice also indicated that the reply time remained as set forth in the original 26 November, 2003, Notice (i.e., until 26 January, 2004), however, Petitioner could request and pay for extensions of time;
- on 1 July, Petitioner filed a request and fee for a five- (5-) month extension of time, which carried Petitioner's reply time from the earlier 26 January, 2004, deadline through Monday 28 June, 2004, and, thus, as of the filing of the extension of time, the application already was abandoned after midnight 26 June, 2004;
- Petitioner filed the second petition on 26 August, 2005, however, as noted above, the application was abandoned after midnight 26 June, 2004, fourteen (14) months earlier;
- nonetheless, the deficiencies with the instant petition—over and above abandonment—include the failure to have an authorized person sign the oath/declaration if no inventors are available to sign (and evidence of the authority of that person to sign), the failure to evidence (with documents) due diligence in attempting to ascertain a current/valid/last known address for the non-signing inventors (over and above the exchange of two Emails stating in essence we looked at Lexis and we looked at Westlaw), the failure to evidence having sent the entire application (description, claims, abstract and drawings) to alleged non-signing inventors Mr. Hegedus, Ms. Krempels, Ms. Paal and Mr. Petho; and it appears that Petitioner also seeks to submit (on 26 August, 2005) an oath/declaration signed by Mr. Hegedus, Ms. Krempels, and Ms. Paal, but that is unclear and it seems wholly unstated.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

- (1) Identify the application to which it is directed;
- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

It appeared from the outset that Petitioner was submitting a wholly unsigned oath/declaration. The commentary at MPEP §409.03(b) provides that, where no inventors are available to sign:

409.03(b) No Inventor Available

Filing under 37 C.F.R. 1.47(b) and 35 U.S.C. 118 is permitted only when no inventor is available to make application. These provisions allow a “person” with a demonstrated proprietary interest to make application “on behalf of and as agent for” an inventor who “can-not be found or reached after diligent effort” or who

refuses to sign the application oath or declaration. The word “person” has been construed by the U.S. Patent and Trademark Office to include juristic entities, such as a corporation. Where 37 C.F.R. 1.47(a) is available, application cannot be made under 37 C.F.R. 1.47(b).

In addition to other requirements of law (35 U.S.C. 111(a) and 115), an application deposited pursuant to 37 C.F.R. 1.47(b) must meet the following requirements:

(A) The 37 C.F.R. 1.47(b) applicant must make the oath required by 37 C.F.R. 1.63 and 1.64 or 1.175. Where a corporation is the 37 C.F.R. 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 C.F.R. 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 C.F.R. 1.47(b).

(B) The 37 C.F.R. 1.47(b) applicant must state his or her relationship to the inventor as required by 37 C.F.R. 1.64.

(C) The application must be accompanied by proof that the inventor (1) cannot be found or reached after a diligent effort or (2) refuses to execute the application papers. See MPEP § 409.03(d).

(D) The last known address of the inventor must be stated. See MPEP § 409.03(e).

(E) The 37 C.F.R. 1.47(b) applicant must make out a *prima facie* case (1) that the invention has been assigned to him or her or (2) that the inventor has agreed in

writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application. See MPEP § 409.03(f).

(F) The 37 C.F.R. 1.47(b) applicant must prove that the filing of the application is necessary (1) to pre-serve the rights of the parties or (2) to prevent irreparable damage. See MPEP § 409.03(g).

Thus, a registered practitioner signing on behalf of the assignee, must state affirmatively that the practitioner is authorized to so sign. (MPEP §409.03(b)).

When one alleges a refusal of the inventor to sign the application papers, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who, *inter alia*, presented the inventor with the application papers and/or to whom the refusal was made.

The commentary at MPEP §409.03(d) provides:

409.03(d) Proof of Unavailability or Refusal

INVENTOR CANNOT BE REACHED

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 C.F.R. §1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 C.F.R. §1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 C.F.R. §1.47. 37 C.F.R. §1.43 may be available under these circumstances. See MPEP §409.02. Such a petition under 37 C.F.R. §1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of

the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

REFUSAL TO JOIN

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 C.F.R. §1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP §106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 C.F.R. §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 C.F.R. §1.47 applicant that a nonsigning inventor's

conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Thus, not only must a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application—and evidence of that transmittal submitted—but also a reasonable effort must be made to ascertain a current or last known address, and the petition (with fee) must state over the signature and registration number of the Petitioner the last known address and, if appropriate, evidence of the due diligence effort ascertaining same.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

(The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.¹)

CONCLUSION

Included among the apparent deficiencies herein are the following:

- the application appears to have gone abandoned after midnight 26 June, 2004;
- if there are no signing inventors, there is a failure to have an authorized person sign the oath/declaration and evidence of the authority of that person to sign (MPEP §409.03(b));
- the failure to evidence (with documents) due diligence in attempting to ascertain a current/valid/last known address for the non-signing inventors;
- the failure to evidence having sent the entire application (description, claims, abstract and drawings) to alleged non-signing inventors Mr. Hegedus, Ms. Krempels, Ms. Paal and Mr. Petho; and
- if, as it seems to appear, Petitioner also seeks to submit an oath/declaration signed by Mr.

¹ See: MPEP 409.03(b).

Hegedus, Ms. Krempels, and Ms. Paal, to so state and to evidence the satisfaction of the assignee's duty to provide to the other non-signing inventor Mr. Petho a copy of the entire application (description, claims, abstract and drawings).

Therefore, the instant petition hereby is **dismissed**.

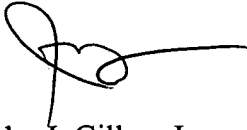
Further correspondence with respect to this matter should be addressed as follows:²

By mail: Commissioner for Patents³
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

² On July 15, 2005, the Central Facsimile (FAX) Number will change from (703) 872-9306 to (571) 273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information. see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

³ To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.